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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,962	01/09/2002	John Kenneth Kirby	46309/268666	2786
23370	7590	05/03/2005		
JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET ATLANTA, GA 30309			EXAMINER NORDMEYER, PATRICIA L	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,962

Applicant(s)

KIRBY, JOHN KENNETH

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 21, 2005 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1 – 12 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “planar layers are each of a similar material” in claim 1 is unclear, which renders the claim vague and indefinite. It is unclear from the claims and specification what is meant by the term “similar”. How is the material of the upper and lower planar layers “similar”? Do they have the same thickness? The same coefficient of expansion? Density? Are they similar because they are made from the same materials or are made up of ratios of the same materials?

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Claim 3 recites the limitation "plastics material is polypropylene" in claim 1. There is insufficient antecedent basis for this limitation in the claim. Claim 3 is dependent on claim 2, which is dependent on claim 1. Both claims 1 and 2 contain the terms "plastic material", wherein claim 2 is referring to the planar layers and claim 1 is referring to the rigid planar tile. Which plastics material is claim 3 referring, the planar layers or the rigid planar tile?

Claim 4 recites the limitation "plastics material is oriented polypropylene" in claim 1. There is insufficient antecedent basis for this limitation in the claim. Claim 4 is dependent on claim 3, which is dependent on claim 2, and claim 2 is ultimately dependent on claim 1. Both claims 1 and 2 contain the terms "plastic material", wherein claim 2 is referring to the planar layers and claim 1 is referring to the rigid planar tile. Which plastics material is claim 4 referring, the planar layers or the rigid planar tile?

Claim 9 recites the limitation "plastics material is selected from polypropylene, oriented polypropylene or polyester" in claim 1. There is insufficient antecedent basis for this limitation in the claim. Claim 9 is dependent on claim 8, which is dependent on claim 7, and claim 7 is ultimately dependent on claim 1. Both claims 1 and 7 contain the terms "plastic material", wherein claim 7 is referring to the planar layers and claim 1 is referring to the rigid planar tile. Which plastics material is claim 3 referring, the planar layers or the rigid planar tile?

Claims 2, 5 – 8, 10 – 12 and 22 are also rejected under 35 U.S.C. 112 2nd paragraph due to their dependency on the above rejected claim 1.

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Correction/clarification is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 – 3, 7 – 9 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bristol et al. (USPN 4,834,502) in view of Scianna (USPN 5,997,995).

Bristol et al. disclose a laminar mat suitable for use as a mouse mat (Column 1, lines 4 – 5) comprising a rigid planar tile of molded plastic material (Column 2, lines 46 – 51; Figure 2, #14) having upon respective upper and lower surfaces respective upper and lower planar layers (Figure 2, #12 and 16), where in the upper and lower planar layers are each a of a similar material (Column 2, lines 19 – 21; Column 2, lines 68 to Column 3, line 1 – wherein the layers are similar due to the fact they are both made from plastics material), the upper layer is textured (Column 2, lines 29 – 30) and the lower layer is provided with non-slip coating which resists the movement of the mat relative to a work surface (Column 2, lines 59 – 61) as in claims 1 and 2. With regard to claim 22, at least one of the planar layers includes a coating with anti-static properties (Column 2, lines 19 – 29). However, Bristol et al. fail to disclose the planar layers non-adhesively bonded therewith, the plastics material being polypropylene, oriented polypropylene or polyester and the planar layers are laminated.

Scianna teaches disclose the planar layers non-adhesively bonded therewith (Column 3, lines 22 – 30), the plastics material is polypropylene and polyester (Column 2, lines 60 – 63) and the planar layers are laminated (Column 3, lines 22 – 30) in a mouse pad (Column 2, line 8) for the purpose of having an improved non-slip mat or pad which is substantially thinner and more compact while provided frictional characteristics to prevent slipping upon substantially any surface (Column 7 – 11).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a plastics material of polypropylene and polyester with planar layers non-adhesively bonded therewith in the mouse pad of Bristol et al. in order to have an improved non-slip mat or pad which is substantially thinner and more compact while provided frictional characteristics to prevent slipping upon substantially any surface as taught by Scianna.

Regarding the “by a mould during molding of the mat” and “with an external screen printed non-slip coating applied after molding” in claim 1, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of attachment of the planar layers due to injection molding is a method of production and therefore does not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of

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patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

6. Claims 4, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bristol et al. (USPN 4,834,502) in view of Scianna (USPN 5,997,995) as applied to claims 1 – 3, 7 – 9 and 22 above, and further in view of Ferrar et al. (USPN 5,578,370).

Bristol et al., as modified with Scianna, discloses a laminar mat suitable for use as a mouse mat comprising a rigid planar tile of molded plastic material having upon respective upper and lower surfaces respective upper and lower planar layers, where in the upper and lower planar layers are each a of a similar material, the upper layer is textured and the lower layer is provided with non-slip coating which resists the movement of the mat relative to a work surface. However, the modified Bristol et al. fail to disclose the plastics material being oriented polypropylene, the planar layer comprising three laminae and each of the three laminae being oriented polypropylene.

Ferrar et al. teach a plastics material of oriented polypropylene (Column 2, lines 47 – 48), the planar layer comprising three laminae and each of the three laminae being oriented

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polypropylene (Column 2, lines 52 – 55) for the purpose of having a composite material that has mechanical strength in the direction of the plane of the fabric in general engineering applications (Column 1, lines 8 – 13).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the oriented polypropylene layers in the modified Bristol et al. in order to have a composite material that has mechanical strength in the direction of the plane of the fabric in general engineering applications as taught by Ferrar et al.

7. Claims 5, 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bristol et al. (USPN 4,834,502) in view of Scianna (USPN 5,997,995) as applied to claims 1 – 3, 7 – 9 and 22 above, and further in view of Higgs (GB 2 289 520 A).

Bristol et al., as modified with Scianna, discloses a laminar mat suitable for use as a mouse mat comprising a rigid planar tile of molded plastic material having upon respective upper and lower surfaces respective upper and lower planar layers, where in the upper and lower planar layers are each a of a similar material, the upper layer is textured and the lower layer is provided with non-slip coating which resists the movement of the mat relative to a work surface. However, the modified Bristol et al. fail to disclose the planar layers comprising paper, cardboard and a lamina of paper provided between the laminae of oriented polypropylene.

Higgs teaches planar layers comprising paper (Figure 3, #1) and cardboard (Figure 3, #2) in a mouse pad (Page 3, claim 1) for the purpose of providing a flat smooth surface that information can be printed onto the surface of the mouse pad (Page 2, lines 1 – 2).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided paper and cardboard in Bristol et al. in order to have a flat smooth surface that information can be printed onto the surface of the mouse pad as taught by Higgs.

The modified Bristol et al. disclose the claimed invention except for the planar layers each comprise a lamina of paper provided between the laminae of oriented polypropylene. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place piece of paper between the laminae of the oriented polypropylene, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Response to Arguments

8. Applicant's arguments with respect to claims 1 – 12 and 22 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer
Examiner
Art Unit 1772

pln
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Harold Pyon
HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

4/29/05